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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,206	05/11/2001	Steve Melnick	C18497/115275	5901

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EXAMINER	
JABR, FADEY S	

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/853,206	MELNICK ET AL.	
	Examiner	Art Unit	
	Fadey S. Jabr	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Independent Claims 1, 16 and 27 have been amended. Dependent Claims 2-3, 5, 7-8, 10, 12, 17-18, 21-24, and 28-30 have been amended. Claims 1-32 remain pending in the application and are again presented for examination.

Response to Arguments

1. Applicant's amendments filed 3 April 2006, with respect to the rejection under 35 U.S.C. section 112, second paragraph, have been fully considered. Therefore the rejection is withdrawn.

2. Applicant's arguments filed 3 April 2006, with respect to the rejection under 35 U.S.C. section 101, have been fully considered. Therefore the rejection is withdrawn.

3. Applicant's arguments filed 20 March 2006, with respect to the rejection under 35 U.S.C. section 103, have been fully considered but they are not persuasive.

4. Applicant's argues (with respect to claims 1, 16 and 27) that Schoenbaum's method of estimating is inaccurate. Applicant alleges that Schoenbaum requires only that the user provide information on the total number of prescriptions that the user may need in the upcoming year and not on a drug-by-drug basis. However, Examiner notes that Schoenbaum discloses for each application of the HCC, one obtains data on the actual health service use of a reference population that is comparable to the particular set of users for which the HCC is intended. Specifically, one obtains medical conditions (i.e. specific prescriptions drugs). Other specific information that is disclosed is analogous descriptors (for prescription drugs, one obtains the drug name, strength dosage, and volume dispensed). Where the price of the health scare services

(i.e. prescriptions medication) are estimated. Where wholesale prices for prescription drugs are also obtained (0046; 0048). Table 3a also discloses a prescription drug cost of the drug used by the employee, the billed charge, and the out–of-pocket cost for plans A and B. The same is done for the employee's spouse. The annual out-of-pocket costs associated with each specific health condition are also calculated, therefore the estimates of the prescription drug utilization are calculated based on the specific drug used to treat the user's specific health condition (0283). For example, if a user is being treated for hypertension, the drug they are prescribed will be for hypertension. Therefore, when the user's utilization quantity is estimated, it is estimated based on a reference population that is equivalent, i.e. has the same medical conditions and consequently the same prescription medication (0327-0330).

Even if Schoenbaum did not disclose utilizing the unit cost of supplying each prescription drug under the plan and estimating the total prescription costs for a consumer based on the consumer's projected prescription drug utilization quantity for each prescription drug, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to estimate a user's cost of prescription drugs for a certain plan based on their predicted use for a specific time.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims **1-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenbaum et al., Pub. No. US2002/0147617 A1 in view of Toan et al., Pub. No US2002/0095316 A1.

As per **Claim 1**, Schoenbaum et al. discloses a method for using a computer apparatus for evaluating a plurality of plans, each plan having one or more plan design options, from which a plurality of consumers may each select one of the plans under which a provider supplies a selecting consumer's prescription drug utilization quantity of one or more prescription drugs, the computer apparatus comprising an input device for receiving input data, a memory device connected to the input device for storing the input data, a processor connected to the memory device which is programmed to perform operations upon the stored data to produce output data, and an output device connected to the processor for outputting the output data, the method comprising the steps of:

- estimating the utilization quantity of each prescription for each consumer, thereby obtaining a projected prescription drug utilization quantity for each consumer (Para. 222; 258, lines 8-10);
- calculating the estimated cost by accumulating the costs of supplying each prescription drug to each consumer under the predicted plan, whereby the cost of supplying each consumer is the sum of the unit cost of each prescription drug multiplied by the consumer's projected prescription drug utilization quantity of that prescription drug, less any payments made by the consumer (Para. 232; 251, lines 11-15);

Nevertheless, Schoenbaum et al. fails to disclose:

- inputting values corresponding to each plan design option in each plan;
- inputting the unit cost of supplying each prescription drug provided under the plans;
- predicting the plan selected by each consumer; and
- outputting the estimated cost.

However, Toan et al. discloses inputting data corresponding to each plan; inputting the unit cost of supplying each product (Para. 5); predicting the plan selected by each consumer (Para. 15), and out the estimated cost (Para. 10). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Schoenbaum et al. and provide the capability to input and output cost and data corresponding to each plan as disclosed by Toan et al. because it would be obvious to want to provide information regarding the prospective plan to the consumer so that they may formulate an informed decision concerning the plan. It would have also been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Schoenbaum et al. and provide the capability for predicting a plan to be chosen by the consumer as disclosed by Toan et al. because in order to provide pertinent information regarding plans to a consumer a prediction based on specific criteria would have to be made in order for the relevant information to be provided.

As per **Claim 2**, Schoenbaum et al. further discloses a method wherein the step of estimating the projected prescription drug utilization quantity of each product for each consumer comprises deriving the estimated utilization quantity from the consumer's historical utilization quantity of the product (Para. 222, Table 3a).

As per **Claim 3**, Schoenbaum et al. further discloses a method wherein the step of estimating the prescription drug utilization quantity of each prescription drug for each consumer comprises deriving the projected prescription drug utilization quantity from the average historical prescription drug utilization quantity of a population segment having at least one demographic, medical or attitudinal characteristic similar to those of each consumer (Para. 232, lines 3-6).

As per **Claims 4, 6, 9, 11, and 13**, Schoenbaum et al. further discloses a method wherein the population segment comprises a representative sample of the consumers (Para. 39).

As per **Claim 5**, Schoenbaum et al. further discloses a method wherein the step of estimating the projected prescription drug utilization quantity of each prescription drug for each consumer is derived from the historical prescription drug utilization quantity of a randomly selected member of a population segment having at least one demographic, medical or attitudinal characteristic similar to those of each consumer (Para. 232, lines 3-6).

As per **Claim 7**, Schoenbaum et al. further discloses a method wherein one or more of the plans requires payments by the consumers and wherein the step of predicting the plan selected by each consumer comprises identifying the plan which requires the minimum payment by each consumer for each consumer's historical utilization quantity of each prescription drug (Col. 24, lines 10-31).

As per **Claims 8, 10, and 12**, Schoenbaum et al. fails to disclose a method wherein the step of predicting the plan selected by each consumer comprises identifying the plan most commonly preferred by a population segment having at least one demographic, medical or attitudinal characteristic similar to those of each consumer. However, Toan et al. discloses a system wherein the best perceived plan is identified by the system using data from a subject group (Para. 15). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Schoenbaum et al. and provide a system that would identify the most preferred plan based on subject group data as disclosed by Toan et al. Toan et al. provides motivation for providing a customer with the most preferred plan according to a subject group with similar demographic characteristics so that the customer may choose the plan with most beneficial options for their current status (Para. 34).

As per **Claims 14, 25, and 31**, Schoenbaum et al. further discloses a method further comprising the step of adjusting the plan design option values according to the difference between a predetermined target cost and the calculated estimated cost (Para. 283; 284).

As per **Claims 15, 26, and 32**, Schoenbaum et al further discloses a method further comprising the step of inputting the predetermined target cost and wherein the step of adjusting the plan design option values according to the difference between the predetermined target cost and the calculated estimated cost is performed by the processor (Para. 283; 284).

As per **Claim 16**, Schoenbaum et al. discloses a computer based system for determining the values corresponding to each plan design option of a plurality of plans, from which a plurality of consumers may each select and under each of which plans a provider supplies each selecting consumer's prescription drug utilization quantity of one or more prescription drug , such that the estimated cost to the provider of supplying the prescription drugs is equal to a predetermined target cost, comprising:

- the processor programmed for estimating the utilization quantity of each prescription drug for each consumer, thereby obtaining a projected prescription drug utilization quantity, predicting the plan selected by each consumer, and calculating the estimated cost by accumulating the costs of supplying each consumer, whereby the cost of supplying each consumer is the sum of the unit cost of each prescription drug multiplied by the consumer's projected prescription drug utilization quantity of that prescription drug, less any payments made by the consumer (Para. 232; 251, lines 11-15); and
- means for adjusting the plan design option values according to the difference between the target cost and the estimated cost (Para. 283; 284).

Nevertheless, Schoenbaum et al. fails to disclose:

- an input device for receiving input data,
- a memory device connected to the input device for storing the input data,
- a processor connected to the memory device which is programmed to perform operations upon stored data to produce output data, and
- an output device connected to the processor for displaying the output data;

- the input device capable of receiving data representing proposed initial values corresponding to each plan design option in each plan and the unit cost of supplying each prescription drug.

However, Toan et al. discloses an input device for receiving input data (Para. 12); a memory device connected to the input device for storing the input data (Para. 13); a processor connected to the memory device which is programmed to perform operations upon stored data to produce output data (Para. 14), an output device connected to the processor for displaying the output data (Para. 15), and the input device capable of receiving data representing proposed initial values corresponding to each plan design option in each plan and the unit cost of supplying each product (Para. 15). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the computer system of Schoenbaum et al. and provide an computer based system to input, store, process and output cost and data corresponding to each plan as disclosed by Toan et al. because it would be obvious to want to provide information regarding the prospective plan to the consumer so that they may formulate an informed decision concerning the plan.

As per **Claim 17, and 28**, Schoenbaum et al. further discloses a system wherein the input device is capable of receiving data representing each consumer's historical utilization quantity of each prescription drug and wherein the processor is programmed for estimating the projected prescription drug utilization quantity of each prescription drug for each consumer as a function of the consumer's historical utilization quantity of each prescription drug (Para. 222; 226; 230; 258, lines 8-10).

As per **Claim 18**, Schoenbaum et al. further discloses a system wherein the processor is programmed for estimating the projected prescription drug utilization quantity of each prescription drug for each consumer as the consumer's historical utilization quantity of each prescription drug (Para. 222; 226; 230; 258, lines 8-10).

As per **Claim 19**, Schoenbaum et al. fails to disclose a system wherein the output device is capable of displaying the estimated cost to a user. However, Toan et al. discloses a method wherein the calculated data is outputted (Para. 10). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Schoenbaum et al. and provide the capability to output the calculated data as disclosed by Toan et al. because it would be obvious to want to display the calculated data corresponding to the plan options to the customer.

As per **Claim 20**, Schoenbaum et al. further discloses a system further comprising means for inputting signals from a user and wherein the means for adjusting the plan design options according to the difference between the target cost and the estimated cost comprises means for adjusting the plan design options according to inputs received from the user (Para. 283, 284).

As per **Claim 21**, Schoenbaum et al. further discloses a system wherein the input device is capable of receiving data representing the average prescription drug utilization quantity of a population segment having at least one demographic, medical or attitudinal characteristic similar to those of each consumer and wherein the processor is programmed for estimating the projected prescription drug utilization quantity of each prescription drug for each consumer as a function

of the average prescription drug utilization quantity of a population segment having at least one demographic, medical or attitudinal characteristic similar to those of each consumer (Para. 39; 222; 226; 230; 258, lines 8-10).

As per **Claim 22**, Schoenbaum et al. further discloses a system wherein the processor is programmed for estimating the projected prescription utilization quantity of each prescription drug for each consumer as the average prescription drug utilization quantity of a population segment having at least one demographic, medical or attitudinal characteristic similar to those of each consumer (Para. 39; 222; 226; 230; 258, lines 8-10).

As per **Claim 23**, Schoenbaum et al. discloses a system wherein the input device is capable of receiving data representing the plan selection criteria preferred by members of a population segment having at least one demographic, medical or attitudinal characteristic similar to those of eachconsumer (Para. 39).

Nevertheless, Schoenbaum fails to disclose:

- wherein the processor is programmed for predicting the plan selected by each consumer as the plan most closely matching the plan selection criteria.

However, Toan et al. discloses a processor that predicts the plan selected by each consumer that closely matches the plan selection criteria (Para. 15). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Schoenbaum et al. and provide the capability for predicting a plan to be chosen by the consumer as disclosed by Toan et al. because in order to provide pertinent information regarding plans to a consumer a

prediction based on specific criteria would have to be made in order for the relevant information to be provided.

As per **Claim 24**, Schoenbaum et al. further discloses a system wherein the processor is programmed for estimating the projected prescription drug utilization quantity of each prescription drug for each consumer as the average utilization quantity of a population segment having at least one demographic, medical or attitudinal characteristic similar to those of the consumer (Para. 39; 222; 226; 230; 258, lines 8-10).

As per **Claim 27**, Schoenbaum et al. discloses a method for using a computer apparatus for evaluating one or more plans, each having one or more plan design options, under which a provider supplies a consumer's prescription drug utilization quantity of one or more prescription drug, the computer apparatus comprising an input device for receiving input data, a memory device connected to the input device for storing the input data, a processor connected to the memory device which is programmed to perform operations upon the stored data to produce output data, and an output device connected to the processor for outputting the output data, the method comprising the steps of:

- estimating the prescription drug utilization quantity of each prescription drug for the consumer, thereby obtaining the projected prescription drug utilization quantity (Para. 222; 258, lines 8-10);
- calculating the cost to the consumer for each plan by accumulating the transactional

cost to the consumer for each prescription drug plus any periodic payments made by the consumer, wherein the transactional cost is the sum of the unit of each prescription drug under the respective plan multiplied by the consumer's projected prescription drug utilization quantity of that prescription drug (Para. 39, Table 3a).

Nevertheless, Schoenbaum et al. fails to disclose:

- inputting values corresponding to each plan design option in each plan;
- outputting the calculated cost.

However, Toan et al. discloses inputting values corresponding to each plan design option in each plan (Para. 5); and outputting the calculated cost (Para 10). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Schoenbaum et al. and provide method for inputting and outputting cost and data corresponding to each plan as disclosed by Toan et al. because it would be obvious to want to provide information regarding the prospective plan to the consumer so that they may formulate an informed decision concerning the plan.

As per **Claim 29**, Schoenbaum et al. further discloses a method wherein the step of estimating the projected prescription drug utilization quantity of each prescription drug for the consumer comprises deriving the projected prescription drug utilization quantity from the average prescription drug utilization quantity of each prescription drug for a population segment having at least one demographic, medical or attitudinal characteristic similar to those of the consumer (Para. 39; 222; 258, lines 8-10).

As per **Claim 30**, Schoenbaum et al. fails to disclose a method further comprising the step of inputting the consumer's expected prescription drug utilization quantity of each prescription drug and wherein the projected prescription drug utilization quantity of each prescription drug for the consumer is equal to the consumer's expected prescription drug utilization quantity of each prescription drug. However, It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Schoenbaum et al. wherein the expected and the estimated utilization quantities for each product for the consumer are equal. For instance, the process of estimating the utilization quantity of the customer is done in order to acquire a value that closely resembles the value the consumer feels is adequate, therefore it would have been obvious to want have both the estimated and the expected value match as closely as possible.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3639

FSJ

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